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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,844

Applicant(s)

RONNING ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-26, 28-48 and 50-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-26, 28-48 and 50-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendment A, paper # 10, received on 04/02/2003 is acknowledged and entered. Claims 5, 27, and 49 have been canceled. Claims 1, 15, 17, 23, 37, 39, 45, 59, and 61 have been amended. Currently claims 1-4, 6-26, 28-48, and 50-66 are pending for examination.

Response to Arguments

2. Applicant's arguments filed with respect to amended claims 1, 23, and 45 (see Amendment page 6) have been fully considered but they are not persuasive as Downs (US Patent 6,226, 618) teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

Applicant's arguments filed with respect to amended claims 17, 39, and 61 (see Amendment page 7) have been fully considered but are moot in view of new grounds of rejection necessitated due to amendment. The newly added limitation of converting the identifier to " a name identifying a type of content of the file " is obvious in view of Downs (US Patent 6,226, 618) and further in view of Official Notice. Downs teaches the use of metadata to refer to the data of the contents of download and metadata is data about the content, such as, a song

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title for the downloaded song and this metadata, such as a song title is used to package the contents and also downloaded to the user (see col.9, lines 15-47). Downs further teaches that an end-user can use a tool to manage and customize his downloaded digital content library (see at least col.83, line 27-col.87, line 8) and thus he can name the downloaded content the way he likes it for his convenience. Downs does not disclose converting the identifier to a name related to the content of the downloaded content. However, It is an old and well-known concept to save and name the files, after selecting/purchasing a download of a content, such that the name of the file relates to the content and nature of the downloaded content, for example, if we write an article for a school/college assignment it is saved with a file name relating to the title of the article or if we extract an article from an external file in our computer memory we name it with a file name relating to its title or the matter. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Downs and incorporate the feature of the Official Notice, that is, to convert the name/identifier of the downloaded file, while saving it, to a name which relates to the title/content of the downloaded matter because it will help the consumers to locate and retrieve the file later immediately without having to check a number of stored files.

In view of amendments made to claims 15, 37, and 59 objection to these claims is withdrawn.

This is a final rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

3.1. Claims 1-4, 7-11, 13-16, 23-26, 29-33, 35-38, 45-48, 51-55, and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs.

3.2. With regards to claims 1-4, 7-11, 16, Downs teaches a method for secure downloading of a file from a network comprising: receiving a selection of a file, receiving an order from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order, verifying the file identifier based upon particular information related to the file comprising verifying a version identifier related to the file and verifying a uniform resource locator, verifying the order identifier based upon particular information related to the order comprising a custom identifier associated with the user, verifying a transaction identifier associated with the order, and the particular information related to the order including : determining if the order identifier is valid for the order, meaning the order identifier exists for the order, determining if the order identifier is active, meaning the order was not canceled before the download of the file, and determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file and selectively permitting the download of the file based upon a number of requested downloads based upon the verification of the file identifier, transaction identifier and the order identifier, receiving a selection of a uniform resource locator for the file and determining if the uniform resource locator is valid, active, non-suppressed or charged, also selectively downloading the file based upon a number of successful downloads of the file and upon a time parameter related to submission of the order, and denying the download based upon a customer identifier associated with the user (at least see, col.3, lines 40-55,*transferring the encrypted data....clearing*

house.....transferring the re-encrypted data.....to the user's system....". col.7, lines 2-16,
"..licensing authorization and control....conditions of purchase and license, such as permitted
number of copies, number of plays, and the time interval or term the license may be valid
.....enabling intermediate or End-User (s) to unlock content after verification of a successful
completion of licensing transaction..", col.8, lines 26-31, "..The architecture is open...Distribution
of audio, programs, multimedia, video or other types of Content....", col.10, lines 19-26, "... Once
an Electronic Digital Content Store(s) 103 completes a valid request for Electronic Content 113
from an End-User(s).....The Electronic Digital Content Stores (s) also authorizes the download
of the SC containing the Content 113 ", col.11, lines 30-54, "..The End-User Device(s) 109 can
be any player deviceThe End-User device (s) 109 manages the download and storage of
SCs containing the Digital Content.....the use or running-on an End-User device(s) ", col.24,
lines 17-47, "... Upon reception of the Order SC9s) 650 from the Ned-User Devices (09), the
Clearinghouse (s) 105 verifies:2. that the order SC (s) 650 has not been
altered.....Transaction Data 642 and Symmetric Key 623 are complete and authentic.....If the
verifications are successful.....transfers the License SC (s) 660 to the End-User Device (s)
109....", col.26,lines 24-58, "... When an End-User Devices (109 receives the
Content.....Instead, the SC (s) includes an external URL.....to point to the Content
113.....Electronic Digital Content Store (s) 103 also.....extracting metadata information from
them to build HTML pages.....present descriptions of Content 113 to End-User (s), usually so
they can purchase the Content 113 ", col.27, lines 6-21, "..The End-User device (s) 109 receives
the Transaction SC (s) 640 and validates the integrity of the Transaction SC (s) 640 and the
included Offer SC (s) 641.....The Clearinghouse (s) 105 validates and processes Order Sc (s)
650...access purchase Content 113 ", col.28, lines 30-50, "... Each record includesa URL
that points to another SC (s) that includes the encrypted part...", col.29 line 18-col.30, line 62,

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"...[Content URL]....Content ID- A part that defines a unique ID assigned to a Content 113 item....SC Version-A version number assigned to the SC (s)...SC ID---", col.33, line 25-col.34, line 50, "...Transaction ID 535...End-User (s) ID---Verify the Digital Signature 643 of the SC (s).....Verify the integrity and authenticity of each Offer SC (s) 641 included in the Transaction Sc (s) 640...", col.40, line 35-col.41, line 4, "...The ID property is a unique value ...T property specifies the type of the SC (s)...A property identifies the author or publisher....D property identifies the date...E property identifies the date, and optionally, the time that the SC (s) expires...CCURL value...CCURL property identifies the URL of the Clearinghouse (s) 105. The value should be the form of a valid external URL...", col.44, lines 5-42, "... Validation....The Clearinghouse(s) 105 begins the validation of Order SC 9s) 650 by verifying the digital signatures.....integrity of the Order SC (s) 650 parts...The process of verification of the Transaction and the Offer Sc (S)Then, the Storage Usage Conditions 519 of the Content 113...are validated by the Clearinghouse (s) 105....", col.45, lines 15-28, "...In all the processing of the Order SC (s) 650 is successful...If the Clearinghouse (s) 105 is not able to successfully process the order SC (s) 650.....The HTML page indicates the reason that the Clearinghouse (s) 105 was unable to process the transaction ", col.46, lines 5-61, col.50, line 34-col.51, line 39, col.54, lines 55-64, col.59, line 7-col.60, line 13, col.72, lines 11-59, col.75, line 1-col.77, line 23, col.79, line 10-col.89, line 20.). Downs further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and

this corresponds to checking if the order is canceled before and after the order. Also see at least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

3.3 With regards to claims 13-15, the steps of requesting identification of a file name for storing the file, displaying a default identification as the file name for storing the file based upon an identification of the file and transmitting the generated file identifier for display to the user are inherent during the download.

3.4 With regards to apparatus claims 23-26, 29-33, 35-38, and computer program product claims 45-48, 51-55, and 57-60, their limitations correspond to method claims 1-4, 7-11, 13-16 and are, therefore, analyzed and rejected similarly.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 6, 12, 17-18, 20-21, 28, 34, 39-40, 42-43, 50, 56, 61-62, and 64-65 are rejected under 35 U.S.C. 103(a) as being obvious over Edgar in view of Official Notice.

4.2. With regards to claim 6, Edgar teaches a method for secure downloading of a file

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from a network as disclosed in claim 1 and analyzed above. Edgar does not teach verifying a cookie file associated with the order. However, as per knowledge generally available both the concept and benefits of using cookies in the client –server architecture are notoriously well known at the time of the invention. In view of the knowledge generally available about using cookies, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Edgar to include the concept of verifying a cookie file associated with the order. Doing so would help the server to identify the users and to provide a customized version of the requested file.

With regards to apparatus claim 28, and computer program product claim 50, their limitations correspond to method claim 6 and are, therefore, analyzed and rejected similarly.

With regards to claim 12, Edgar teaches a method for secure downloading of a file from a network as disclosed in claim 1 and analyzed above. Edgar does not state storing the file in a temporary folder during the download. However, as per knowledge generally available both the concept and benefits of storing the file in a temporary folder during the download are notoriously well known at the time of the invention. In view of the knowledge generally available about storing the file in a temporary folder during the download, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Edgar to include this concept of storing the file in a temporary folder during the download. Doing so would help the users to copy the file to be downloaded first on a temporary file to just view it to decide to download or not.

With regards to apparatus claim 34, and computer program product claim 56, their limitations correspond to method claim 12 and are, therefore, analyzed and rejected similarly.

4.3. With regards to method claims 17-18, and 20-21, Downs teaches converting file identifiers for use in generating default storage file names for the corresponding files comprising: receiving an identifier related to a file, a request to download a file, receiving a uniform resource locator related to the file, converting the identifier to a name related to content of the file (at least see, col.26, lines 36-46, "*.....End-User (s) efficiently download the containers.....the SC (s) includes an external URL.....*", col.27, lines 6-17, col.28, lines 32-37, col.29, lines 18-33, "*....[Content URL].....Content ID-A part that defines a unique ID assigned to a content 113 item...*", col.72, lines 35-59, "*... To handle the downloading of merchandize, the Electronic Digital Content Store (s) 103 is given a product ID.....for each downloadable product that it acquires from the Content Promotions Web Site 156 for the Content Provider (s) 101.....These functions interact with the web server's commerce services to create and download to the End-User Device (s) 109 the files necessary.....*", and col.75, line 1-col.77, line 23). The steps of displaying a screen having a section displaying the name in a request for a file name and permitting the user to enter a file name for storing the file are inherent when copying and downloading files from a remote server to client's computer.

Downs further teaches the use of metadata to refer to the data of the contents of download and metadata is data about the content, such as, a song title for the downloaded song and this metadata, such as a song title is used to package the contents and also downloaded to the user (see col.9, lines 15-47). Downs also teaches that an end-user can use a tool to manage and customize his downloaded digital content library (see at least col.83, line 27-col.87, line 8)and thus he can name the downloaded content the way he likes it for his convenience.

Downs does not disclose converting the identifier to a name related to the content of the downloaded content. However, It is an old and well-known concept to save and name the files,

after selecting/purchasing a download of a content, such that the name of the file relates to the content and nature of the downloaded content, for example, if we write an article for a school/college assignment it is saved with a file name relating to the title of the article or if we extract an article from an external file in our computer memory we name it with a file name relating to its title or the matter. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Downs and incorporate the feature of the Official Notice, that is, to convert the name/identifier of the downloaded file, while saving it, to a name which relates to the title/content of the downloaded matter because it will help the consumers to locate and retrieve the file later immediately without having to check a number of stored files.

4.4. With regards to apparatus claims 39-40, 42-43, and computer program product claims 61-62, and 64-65, their limitations correspond to method claims 17-18, 20-21 and are, therefore, analyzed and rejected similarly.

5. Claims 19, 22, 41, 44, 63, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and further in view of Gross et al. (US Patent 6,263,353).

5.1. With regards to claims 19 and 22, Downs teaches a method for converting file identifiers for use in generating default storage file names for the corresponding files and receiving a uniform resource locator related to the file as disclosed in claim 18 and analyzed above. Downs does not disclose the steps of changing a format/network address of the uniform resource locator to accommodate particular web browsers. However, Gross discloses changing a format/network address of the uniform resource locator (col.1, line 59-col.2, line 52, "...As

described above network addresses are recorded in differing formats.....In one aspect of the present invention, a method is provided for converting digital data representations...", Col.3, lines 1-2, "*..FIG.4a diagram illustrating a specific example of a network address conversion...*", and col.3, line 32-col.4, line 4, "*.....As shown in FIG.2 the network monitor 110 includes a conversion module 210 that converts the particular network address format.....to another address format.....*"). In view of Gross, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Downs to incorporate the feature of changing a format/network address of the uniform resource locator to accommodate particular web browsers. Doing so would help to the correct decoding of the whole network address, represented in different ways, at the receiving end of an address received from another computer, as suggested by Gross (at least see, col.1, lines 13-31).

5.2. With regards to apparatus claim 41, and 44, and computer program product claims 63, and 66, their limitations correspond to method claims 19, and 22 and are, therefore, analyzed and rejected similarly.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

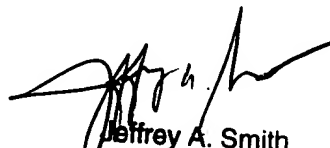
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
June 9, 2003



Jeffrey A. Smith
Primary Examiner